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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/005,534

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Philip W. Eggleston

EGGL-0001D2

9272

7590

10/25/2006

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EXAMINER

LEE, GILBERT Y

ART UNIT

PAPER NUMBER

3673

DATE MAILED: 10/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/005,534

Applicant(s)

EGGLESTON, PHILIP W.

Examiner

Gilbert Y. Lee

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --.

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/23/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-14, 16 and 18-34 is/are pending in the application.
- 4a) Of the above claim(s) 23-32 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 4-13, 33 and 34 is/are allowed.
- 6) ☒ Claim(s) 14 and 18-21 is/are rejected.
- 7) ☒ Claim(s) 16 and 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 8/28/06 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 9 and 11 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9 and 11 both recite "a shaft". Claim 1 recites "a shaft" as well. It is unclear to the examiner whether applicant wishes to have two separate shafts or one shaft. Because an amendment was filed, the examiner is interpreting the claims as to read as "the shaft" meaning that there is only one shaft in the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 14 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Scobie et al. (US Patent No. 4,659,064).

Regarding claim 14, the Scobie et al. reference discloses a rotary valve (Fig. 1) comprising: a valve body (12) having an interior (Fig. 1); a seal structure (28) carried by said valve body and defining a seating surface (surface at 34); a disc (32) carried within said valve body interior for rotation; a shaft (36) having a first longitudinal portion (portion of shaft 36 inside of the valve body) and a second longitudinal portion (portion of shaft 36 outside of the valve body); and abutting fixed geometry structures (including 48, 49, 42, 46) including first (48) and second (49) stationary guide structures spaced apart and extending inwardly into said interior of said valve body (Fig. 1), and a mounting structure (42, 46) having oppositely facing surfaces spaced apart (Fig. 1) and abutting said first and second guide structures such that said first longitudinal portion of said shaft rotatably extends through said first guide structure (Fig. 1).

Regarding claim 18, the Scobie et al. reference discloses the first and second guide structures having a portion rotatably coupled to said mounting structure (Fig. 1). Note that the first and second guide structures are bearings (Col. 3, Lines 5-7) thus making the guide structures rotatably coupled to the said mounting structure through the shafts 36 and 38).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scobie et al. in view of Bylsma.

Regarding claims 19-21, the Scobie et al. reference discloses a rotary valve (Fig. 1) comprising: a valve body (12); a seal structure (28) carried by said valve body and defining a seating surface (surface at 34); a disc (32) carried within said valve body interior for rotation; a shaft (36) having a first longitudinal portion (portion of shaft 36 inside of the valve body) and a second longitudinal portion (portion of shaft 36 outside of the valve body); and abutting fixed geometry structures (including 48, 49, 42, 46) including first (48) and second (49) guide structures spaced apart and extending inwardly into said interior of said valve body (Fig. 1), and a mounting structure (42, 46) having oppositely facing surfaces spaced apart (Fig. 1) and abutting said first and second guide structures such that said first longitudinal portion of said shaft rotatably extends through said first guide structure (Fig. 1).

However, the Scobie et al. reference fails to explicitly disclose an actuator support structure connected to an actuator.

The Bylsma reference, a butterfly valve, discloses an actuator support structure (42). The actuator support structure is an one-piece, U-shaped construction with spaced leg portions (43) for removably securing the support to the valve body.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Scobie et al. reference by including an actuator support structure as taught by the Bylsma reference in order to provide a protective cover for the actuator (Bylsma Col. 2, Lines 21-23).

Allowable Subject Matter

5. Claims 1, 4-7, 10, 12, 13, 33, and 34 are allowed.
6. Claims 9 and 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
7. Claims 16 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments, see section IV paragraphs 1 and 2, filed 8/28/06, with respect to 103 rejections of claims 1, 4-7, 9 and 10 have been fully considered and are persuasive. The 103 rejections of claims 1, 4-7, 9, and 10 have been withdrawn.

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9. With regards to the applicant's argument of claims 14 and 18, the argument is not persuasive because the examiner is considering elements 48 and 49 (bearing elements) to be the claimed "fixed geometry structures". Because elements 48 and 49 are bearing elements, they are considered to be stationary. It can also be seen in Fig. 1 that elements 48 and 49 are extending inwardly in the valve body.

10. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., stationary guide structures in claim 19) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gilbert Y. Lee whose telephone number is 571-272-5894. The examiner can normally be reached on 8:00 - 4:30, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia L. Engle can be reached on (571)272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GL
October 19, 2006

A handwritten signature in black ink, appearing to read 'Patricia Engle', with a stylized flourish at the end.

Patricia Engle
Supervisory Examiner
Tech. Center 3600
10-23-2006